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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,970	12/01/2003	Chung J. Lee	QTII-8024US2 DBB	3028
7590	10/19/2005			
Sheldon R. Meyer FLIESLER DUBB MEYER & LOVEJOY LLP Fourth Floor Four Embarcadero Center San Francisco, CA 94111-4156			EXAMINER PARSA, JAFAR F	
			ART UNIT	PAPER NUMBER
			1621	
DATE MAILED: 10/19/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/724,970	Applicant(s) LEE ET AL.	
	Examiner Jafar Parsa	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 71,72 and 74-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 71,72 and 74-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed on 7/26/2005 has been entered. Claims 71, 72 and 74-77 are pending.
2. The rejection of claims 71, 72 and 74-77 as being unpatentable over Biefedt et al is maintained for reasons of record as set forth in the office action mailed on March 21, 20085.

Applicant's arguments filed on 7/26/2005 have been fully considered but they are not persuasive. Applicant states that " the 378 patent discloses a very large number of potential positions on the Ar moiety that can have leaving groups (e.g., 5 or more), whereas the instant application claims compounds having only a small number of leaving group (2 or 3). Moreover, the 378 patent discloses a very large number of functional groups appended to the Ar group (i.e., (Rf)_m and (X)_n) that are not a single methylene group (i.e. CH₂) or a fluorinated methylene group (CF₂-) as claimed".

The examiner notes that the instant claimed invention also, discloses a very large number of potential positions on the Ar moiety that can have many leaving groups (e.g., 1 to 6, wherein -Ar-(Y')_z where z is an integer of 1 to about 6). Also, the 378 reference teaches that (Rf)_m and (X)_n can be a single methylene group or a fluorinated methylene group as claimed in the instant claimed application. See formula 1 lines 55-68 where Rf represent fluorine or fluorine containing radical having 1 to 4 carbon atoms and 1 to 6 fluorine atoms.

Applicant argues that the 378 patent teaches away from the instant claims because by replacing a leaving group with hydrogen will not produce an intermediate

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that can form a polymer as claimed. The examiner notes that there is no evidence to substantiate the applicant claims that all the leaving groups are replaced by hydrogen. Furthermore, applicant's claimed invention is directed to a **compound** for making a polymer. A preamble (polymer) that recites the use or purpose of the claimed invention generally does not limit the claims (Catalina, 62 USPQ2nd at 1785). The body of the claims following the preamble is a self-contained description of the structure and does not depend on the preamble for completeness (Eowe, 42 USPQ2nd at 1553; and IMS Technology Inc. v. Haas Automation Inc., 54 USPQ2nd 1129, 1137 (Fed. Cir. 2000)).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jafar Parsa whose telephone number is (571)272-0643. The examiner can normally be reached on 8 a.m.-4:30 p.m. (M-F).

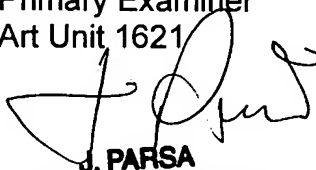
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571)272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JP

Jafar Parsa
Primary Examiner
Art Unit 1621



J. PARSA
PRIMARY EXAMINER